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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*#281 Appeal Brief  
11/21/02  
a.s.*

In re the Application of:

**Kenneth Harrenstien et al.**

Serial No.: 08/891,301

Filed: July 10, 1997

**For: DATA COMMUNICATION PROTOCOLS  
FOR A MOBILE-BASED CLIENT-SERVER  
SYSTEM OVER A WIRELESS NETWORK**

)  
) Group Art Unit: 2684

)  
) Examiner: Pablo N. Tran

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**APPEAL BRIEF UNDER 37 CFR § 1.192**

**Box AF**  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

The Applicants submit this Appeal Brief pursuant to the Notice of Appeal filed in this case on September 9, 2002. This brief is submitted in triplicate.

**I. REAL PARTY IN INTEREST**

The real party in interest is the assignee Oracle Corporation of Redwood Shores, California.

**II. RELATED APPEALS AND INTERFERENCES**

Based on information and belief, there are no appeals or interferences that could directly affect or be directly affected by or have a bearing on the decision by the Board of Patent Appeals and Interferences in the

11/14/2002 pending appeal  
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### **III. STATUS OF CLAIMS**

Claims 1-8, 10-12, and 16-25 are pending in the subject application. Claims 9 and 13-15 have been cancelled. Appeal is taken from the Examiner's rejection of claims 1-8, 10-12, and 16-25.

### **IV. STATUS OF AMENDMENTS AFTER FINAL REJECTION**

A final rejection to claims 1-8, 10-12, and 16-25 was made in the Office action mailed May 8, 2002. In response to the Office action mailed May 8, 2002, Applicants filed an amendment after final rejection on June 7, 2002. The Examiner indicated in an Advisory Action mailed July 16, 2002 that, for purposes of Appeal, this amendment after final rejection would not be entered. Applicants filed a second amendment after final rejection on September 9, 2002. In a second Advisory Action mailed October 7, 2002, the Examiner indicated that, for purposes of Appeal, the second amendment after final rejection would not be entered.

### **V. SUMMARY OF THE INVENTION**

The present invention is defined by the pending claims and their equivalents. The present section of the Appeal Brief is set forth merely to comply with the requirements of 37 C.F.R. § 1.192(c)(5) and is not intended to limit the pending claims in any way. See M.P.E.P. § 1206.

As shown in Fig. 1, a mobile-based client-server system (20) that allows for the efficient transfer of information from a server (22) to a mobile client station (30) via a wireless network (27). (Spec. pg. 6, ll. 2-4).

In an embodiment, a client station (30) in a mobile-based client-server system (20) is adapted for communication with a respective GSM-based wireless communication transceiver (32) ("client station transceiver"), e.g., by a communication port configured for connecting to a GSM-based wireless telephone set. (Spec. pg. 6, ll. 5-9; Fig. 1). A centralized server (22) that periodically receives or otherwise generates information to be delivered to the client station (30) is connected, via a GSM-based wireless communication network (27), to an associated transceiver (28) ("server transceiver"). (Spec. pg. 6, ll. 9-13; Fig. 1). Upon

receiving or generating a selected threshold of information to be delivered to the client station (30), the server generates a signal containing a telephonic address of the client station (30) and a message (e.g., alpha, numeric, binary, or some combination thereof) indicating that the server has information waiting for the client station (30). (Spec. pg. 6, ll. 13-19; Fig. 1). The server relays the signal to the GSM transceiver (28), which then transmits the message to the client station transceiver (32) in the form of a wireless communication page, based on the telephonic address. (Spec. pg. 6, ll. 19-22; Fig. 1).

In particular, by way of an example, the server transceiver (28) employs a GSM-based short message service ("SMS"), which allows users to send and receive point-to-point alphanumeric messages up to a certain byte limit. (Spec. pg. 6, l. 23 to pg. 7, l. 2; Fig. 1).

If the client station (30) is connected to its transceiver (32), the message from the server (22) is immediately received by the client station (30), which is thereby notified of the waiting information. (Spec. pg. 7, ll. 3-5; Fig. 1). In particular, the message will preferably (at least) identify both the type and quantity of information waiting at the server for the respective client station. (Spec. pg. 7, ll. 6-8; Fig. 1). If the information type and/or quantity meet selected thresholds of the client station (30), it then establishes a wireless OTA connection to server (22) (i.e., via the respective client station and server transceivers (28, 32)), and the waiting information is then transferred from the server (22) to the client station (30). (Spec. pg. 7, ll. 8-13; Fig. 1).

If the client station (30) is not connected to its transceiver (32), receipt of the message from the server is preferably detected by a user of the client station (30) (i.e., by an audible ring or mechanical vibration), who can then connect the transceiver (32) to the client station (30) so that it may receive and analyze the message. (Spec. pg. 7, ll. 14-19; Fig. 1). Alternately, the message may be viewed by the user on a display screen (33) provided with the transceiver (32), wherein the user can then decide whether to establish a communication link between the client station (30) and the server (22). (Spec. pg. 7, ll. 19-22; Fig. 1).

In either event, once a communication link is established, other information may also be exchanged between the server (22) and client station (30) – i.e., which was not otherwise a high enough priority to justify the cost of making and maintaining a wireless connection. (Spec. pg. 7, l. 23 to pg. 8, l. 2; Fig. 1).

Full advantage may be taken of the intelligent paging services built into GSM-based SMS paging service. (Spec. pg. 8, ll. 3-5; Fig. 1). Thus, the server (22) can be configured to provide extensive information about the type, quantity, and importance of the information waiting at the server (22). (Spec. pg. 8, ll. 5-8; Fig. 1). Intelligent filtering options can be employed at the server (22), client station (30), or both. (Spec. pg. 8, ll. 8-9; Fig. 1). By way of example, a filter can be set to activate the SMS paging notification of a client station (30) only if certain types or quantities of information are waiting at the server (22). (Spec. pg. 8, ll. 9-12; Fig. 1). Likewise, a filter can be set at a respective client station (30) so that a responsive wireless communication link is only established if selected information type or quantity thresholds are waiting at the server (22). (Spec. pg. 8, ll. 12-15; Fig. 1).

In alternate embodiments, the paging activities may be controlled by the server (22) itself, or by a specific application on the server (22). (Spec. pg. 8, ll. 16-18; Fig. 1).

## **VI. ISSUE**

The issue presented is whether claims 1-8, 10-12, and 16-25 are patentable under 35 U.S.C. § 103(a) over U.S. Patent 5,850,517 issued to Verkler et al. in view of U.S. Patent 5,958,006 issued to Eggleston et al.

## **VII. GROUPING OF THE CLAIMS**

For purposes of the present appeal: Claims 1-8, 10-12, and 16-25 stand or fall together.

## VIII. ARGUMENTS

### Rejections under 35 U.S.C. § 103(a)

In the final Office action of May 8, 2002, the Examiner rejected claims 1-8, 10-12, and 16-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,850,517 issued to Verkler et al. (hereinafter “the ‘517 patent”) in view of U.S. Patent 5,958,006 issued to Eggleston et al. (hereinafter “the ‘006 patent”).

Applicants respectfully submit that under 35 U.S.C. § 103(c), the Examiner cannot rely upon the ‘517 patent as basis for the obviousness rejection under 35 U.S.C. § 103(a). 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject application was filed on July 10, 1997, prior to the issuance of the ‘517 patent on December 15, 1998. Thus, the ‘517 patent qualifies as prior art only under 35 U.S.C. § 102(e) and therefore may be disqualified as prior art under the provisions of 35 U.S.C. § 103(c). M.P.E.P. § 706.02(l)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application[s] filed under 37 CFR 1.53(d), and reissues.

During prosecution of the subject application, a continued prosecution application under 37 C.F.R. § 1.53(d) was filed on April 5, 2000. A copy of the continued prosecution application is attached as Exhibit A. Accordingly, the amended 35 U.S.C. § 103(c) is applicable to the subject application. M.P.E.P. § 706.02(l)(2) states:

In order to be disqualified as prior art under 35 U.S.C. § 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made.

The subject application and the '517 patent were, at the time the invention of the subject application was made, owned by Oracle Corporation. Assignment of U.S. Patent Application No. 08/521,660, which issued as the '517 patent, was recorded on January 11, 1996 at Reel/Frame: 7771/0039 and corrected on September 20, 1996 at Reel/Frame: 8443/0089. Assignment of the subject application was recorded on July 10, 1997, the filing date of the subject application, at Reel/Frame 8686/0687. Copies of the Notices of Recordation of Assignment Document for the subject application and the '517 patent are attached as Exhibits B, C, and D.

Accordingly, the '517 patent is disqualified as prior art under 35 U.S.C. § 103(c). Therefore, rejection of claims 1-8, 10-12, and 16-25 under 35 U.S.C. § 103(a) as being unpatentable over the '517 patent in view of the '006 patent cannot stand. In view of the foregoing, reversal of the Examiner's rejections is respectfully requested.

**IX. CONCLUSION**


For the above reasons, Applicants respectfully submit that rejection of claims 1-8, 10-12, and 16-25 based on 35 U.S.C. § 103(a) has been overcome. Accordingly, Applicants request that the Board of Patent Appeals and Interferences overrule the Examiner and allow claims 1-8, 10-12, and 16-25.

Respectfully submitted,

Bingham McCutchen LLP

Dated: 11-8-02

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